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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVE SNOWDON, CHRISTER FERNSTROM,  
MARC DYMETMAN, and NATALIE S. GLANCE

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Appeal 2008-0927  
Application 09/745,927  
Technology Center 2600

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Decided: June 11, 2008

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Before KENNETH W. HAIRSTON, ANITA PELLMAN GROSS, and KARL  
EASTHOM, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1, 3 through 6, 10, 11, and 13 through 20, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a programmable document including a physical document and a computer attached to the document. The computer

includes a memory with recorded information in digital form and all metadata pertaining to the document. *See generally* Spec. 3:14-18. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A programmable document, comprising:

a physical document including at least one sheet of material and information recorded thereon; and

a computer attached to the physical document, wherein the computer includes

an input/output device,

a memory storing the recorded information in digital form, any updates and modifications to the recorded information, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information,

a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document, and

a computer program, stored in the memory, for implementing defined actions, operable by the processor, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Friedman	US 5,417,508	May 23, 1995
Klotz	US 5,459,307	Oct. 17, 1995
Choksi	US 6,477,243 B1	Nov. 05, 2002
		(filed Apr. 29, 1998)
Porter	US 6,533,171 B1	Mar. 18, 2003

Ostrover	US 6,585,154 B1	(filed Oct. 12, 1999) Jul. 01, 2003 (filed Aug. 03, 2000)
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Claims 1, 3, 5, 10, 11, 13, 15 through 17, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ostrover in view of Porter.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ostrover in view of Porter and Klotz.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ostrover in view of Porter Choksi.

Claims 4 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ostrover in view of Porter and Friedman.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ostrover.

We refer to the Examiner's Answer (mailed May 3, 2007) and to Appellants' Brief (filed December 22, 2006).

### SUMMARY OF DECISION

As a consequence of our review, we will affirm the obviousness rejections of claims 1, 3 through 6, 10, 11, and 13 through 20.

### OPINION

Each of independent claims 1 and 10 recites, in pertinent part, a computer attached to a physical document, the computer including a processor, a computer program, and a memory storing all metadata pertaining to the document. The Examiner asserts (Ans. 4) that Ostrover discloses a physical document and a microchip containing metadata attached

to the document. The Examiner (Ans. 5) asserts that Ostrover does not disclose that the claimed processor and computer program are located within the microchip. The Examiner asserts (Ans. 6) that Porter discloses an iButton, and that it would have been obvious to "execute the processes, disclosed by Ostrover as being performed by the computing device, by the iButton ... to provide a low-cost low-effort solution to storing information." Appellants contend (Br. 8-10) that neither Ostrover nor Porter discloses storing all metadata pertaining to the document. Also, Appellants contend (Br. 11) that Porter teaches away from the combination as Porter teaches eliminating the use of paper for business cards. The issue before us is whether it would have been obvious to store all metadata on the computer attached to a physical document.

Ostrover discloses (col. 5, ll. 15-19) that a chip loading device may be in a computer. The computer from which data is loaded onto the chip would contain all of the metadata associated with the document. Porter shows that computers such as iButtons are known and used in the business world. Porter discloses (col. 4, ll. 35-49) that smart cards such as iButtons are preloaded with applications such as a method for storing information on the card. It would have been obvious in view of Porter's disclosure of smart cards and iButtons to attach a complete computer to Ostrover's document instead of a microchip that requires a separate computer for loading stored metadata into the microchip. Using the iButton disclosed by Porter would clearly eliminate the extra hardware and allow electronic information pertaining to the document to be stored at the document itself instead of in a separate computer. If the metadata for a document is normally stored in a memory in a separate computer, and the combination of Ostrover and Porter

results in the computer being attached to the document, then either the computer attached to the document would include the metadata or it would have been obvious for the metadata to be included so as to eliminate the need to access a separate computer for such information.

The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider "the background knowledge possessed by a person having ordinary skill in the art" and "the inferences and creative steps that a person of ordinary skill in the art would employ." *See KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007). Here the storage of all metadata in the iButton or smartcard rather than in a separate computer (where metadata would normally be stored) would have been the logical result of using an iButton or smartcard rather than a separate computer. Accordingly, including all metadata in the programmable document would have been obvious over Ostrover in view of Porter.

Regarding Appellants' contention that Porter teaches away from the combination, Porter was applied merely as evidence that iButtons and their capabilities were known. Porter was not used for specific teachings related to Porter's invention. Accordingly, we find Appellants' arguments unpersuasive, and we will sustain the obviousness rejection of claims 1 and 10 and their dependents, claims 3, 5, 11, 13, 15 through 17, and 19 over Ostrover and Porter.

As to the rejections of claims 4, 6, 14, and 18, Appellants provide no arguments directed to the additional references of Klotz for claim 6, Choksi for claim 18, and Friedman for claims 4 and 14, but instead assert that nothing in any of the three above-noted references "overcomes the lack of

teachings in Ostrover and Porter." Since we have found no lack of teachings in the combination of Ostrover and Porter, we will sustain the rejections of claims 4, 6, 14, and 18 for the same reasons as indicated *supra* regarding claims 1 and 10.

For claim 20, the Examiner (Ans. 11-12) applies Ostrover alone under 35 U.S.C. § 103. However, claim 20 depends from claim 16, which in turn depends from claim 1, and, therefore, includes all of the limitations of claims 1 and 16. The Examiner rejected claims 1 and 16 over the combination of Ostrover and Porter, asserting (Ans. 5) that Ostrover alone failed to disclose that "the processor and the computer program are located within the microchip." Accordingly, Ostrover fails to disclose all of the limitations of claim 20, and the Examiner has presented no rationale as to why the missing limitations would have been obvious. Therefore, we cannot sustain the obviousness rejection of claim 20 over Ostrover.

#### ORDER

The decision of the Examiner rejecting claims 1, 3 through 6, 10, 11, and 13 through 20 under 35 U.S.C. § 103 is reversed as to claim 20 but affirmed as to the remaining claims.

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Application 09/745,927

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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